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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/553,012	04/20/2000	Marc Eller	12179-P081US	4248

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EXAMINER

NGUYEN, KEVIN M

ART UNIT	PAPER NUMBER
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2674

18

DATE MAILED: 05/19/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/553,012

Applicant(s)

ELLER ET AL.

Examiner

Kevin M. Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14,16-25,27-35,37-41 and 55 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

- 5) ☐ Claim(s) _____ is/are allowed.

- 6) ☒ Claim(s) 14,16-25,27-35,37-41 and 55 is/are rejected.

- 7) ☐ Claim(s) _____ is/are objected to.

- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:--
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 15. 6) ☐ Other: _____

DETAILED ACTION

1. Applicant has complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. 119(e) as follows:

This application is claiming the benefit of a prior filed 4/22/1999 nonprovisional application under 35 U.S.C. 120, 121, or 365(c) that overcomes Carney et al filing date 11/10/1999.

Therefore, applicant's arguments, see page 2 through page 8, line 12, filed 03/03/2003, with respect to claims 14, 16-25, 27-35, 37-41 and 55 have been fully considered and are persuasive. The rejections of claims 14, 16-25, 27-35, 37-41 and 55 based on Carney et al in view Royal, Jr. et al have been withdrawn.

However, the rejections of claims 14, 16-25, 27-35, 37-41 and 55 based on Royal, Jr. et al in view of Adler et al have been maintained.

Specification

2. The disclosure is objected to because of the following informalities: The disclosure is objected to because it contains an embedded hyperlink and/or other form of browser-executable code. Applicant is required to delete the embedded hyperlink and/or other form of browser-executable code. See MPEP § 608.01. Appropriate correction is required.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 14, 16-25, 27-35, 37-41 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Royal, Jr et al (US 5,980,090) hereinafter Royal in view of Adler et al (IDS) (US 6,009,409).

As to claim 14, Royal teaches a method of displaying information 10 having a plurality of displays advertising 38 (an electronic billboard as claimed) that are located on a list A, B, C and D of the map (see figure 7a); each fuel dispenser 12 having an input device or keypad 40, a card reader 41 (an information handling system as claimed) coupling via accessing a homepage for logging onto the site's asset management system 300 (see col. 8, lines 35-37). The system may control the advertising remotely from the advertising commercials (318) posting interface page 308, which leads to advertising or commercials (318) and provide a way to change advertising and also upload information and advertising at the convenience store or other area in the fueling environment, respectively (see figure 7B, col. 8, lines 50-59). Accordingly, a display 38 at location A corresponds to a first electronic billboard; a display 38 at location B corresponds to a second electronic billboard. Each fuel dispenser 12 having an input device or keypad 40, a card reader 41 correspond to a first and a second an information handling system as claimed. The operation display 52 and input 54 (figure 2) corresponding to the claimed a third information handling system as claimed. Royal teaches the user at the browser 25, 27 that will select a device from the list of possible devices on the site network, such as a fuel dispenser, and will

connect to the HTTP server on the target device (col. 7, lines 34-37) including a map of North America (see figure 7a). Royal fails to teach "selecting, via the third information handling system, a time period for displaying the information on the selected electronic billboard; and display the information on the selected electronic billboard during the selected time period." However, Adler teaches a system which includes a time allocation controller that allocates time available in a particular advertising region in a display device of a function of one of a desired user frequency, a desired time frequency, or a desired geometry, that delivers the advertisements to remote computer for display in the advertising region according to the allocating of the time (abstract). Since Adler teaches remote computers 105a to 105n include public networks of computers via the Internet 115 (figure 1, col. 3, lines 55-57). Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the third information handling system (105a) selecting a time period (110) for displaying advertised information (205) taught by Adler on Royal's selected electronic billboard system because client would visit web site at any computers that having Internet to advertise the advertisements via Internet interface.

As to claim 16, Royal teaches the user at the Brower 25, 27 that will select a device form the list of possible devices on the site network, such as a fuel dispenser, and will connect to the HTTP server on the target device 108 (see col. 7, lines 34-37).

As to claims 17 and 55, Royal teaches a method of displaying information 10 having a plurality of displays advertising 38 (an electronic billboard as claimed) that are located on a list A, B, C and D of the map (see figure 7a); each fuel dispenser 12 having

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an input device or keypad 40, a card reader 41 (an information handling system as claimed) coupling via accessing a homepage for logging onto the site's asset management system 300 (see col. 8, lines 35-37). The system may control the advertising remotely from the advertising commercials (318) posting interface page 308, which leads to advertising or commercials (318) and provide a way to change advertising and also upload information and advertising at the convenience store or other area in the fueling environment, respectively (see figure 7B, col. 8, lines 50-59). Accordingly, a display 38 at location A corresponds to a first electronic billboard; a display 38 at location B corresponds to a second electronic billboard. Each fuel dispenser 12 having an input device or keypad 40, a card reader 41 correspond to a first and a second an information handling system as claimed. The operation display 52 and input 54 (figure 2) corresponding to the claimed a third information handling system as claimed. Royal teaches the user at the browser 25, 27 that will select a device from the list of possible devices on the site network, such as a fuel dispenser, and will connect to the HTTP server on the target device (col. 7, lines 34-37) including a map of North America (see figure 7a). Royal fails to teach "selecting, via the third information handling system, a time period for displaying the information on the selected electronic billboard; and display the information on the selected electronic billboard during the selected time period." However, Adler teaches a system which includes a time allocation controller that allocates time available in a particular advertising region in a display device of a function of one of a desired user frequency, a desired time frequency, or a desired geometry, that delivers the advertisements to remote computer

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for display in the advertising region according to the allocating of the time (abstract).

Since Adler teaches remote computers 105a to 105n include public networks of computers via the Internet 115 (figure 1, col. 3, lines 55-57). Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the third information handling system (105a) selecting a time period (110) for displaying advertised information (205) taught by Adler on Royal's selected electronic billboard system because client would visit web site at any computers that having Internet to advertise the advertisements via Internet interface.

As to claims 18 and 23, Royal teaches a method of displaying information 10 having a plurality of displays advertising 38 (an electronic billboard as claimed) that are located on a list A, B, C and D of the map (see figure 7a); each fuel dispenser 12 having an input device or keypad 40, a card reader 41 (an information handling system as claimed) coupling via accessing a homepage for logging onto the site's asset management system 300 (see col. 8, lines 35-37). The system may control the advertising remotely from the advertising commercials (318) posting interface page 308, which leads to advertising or commercials (318) and provide a way to change advertising and also upload information and advertising at the convenience store or other area in the fueling environment, respectively (see figure 7B, col. 8, lines 50-59). Accordingly, a display 38 at location A corresponds to a first electronic billboard; a display 38 at location B corresponds to a second electronic billboard. Each fuel dispenser 12 having an input device or keypad 40, a card reader 41 correspond to a first and a second an information handling system as claimed. The operation display 52

and input 54 (figure 2) corresponding to the claimed a third information handling system as claimed. Royal teaches the user at the browser 25, 27 that will select a device from the list of possible devices on the site network, such as a fuel dispenser, and will connect to the HTTP server on the target device (col. 7, lines 34-37) including a map of North America (see figure 7a). Royal fails to teach "selecting, via the third information handling system, a time period for displaying the information on the selected electronic billboard; and display the information on the selected electronic billboard during the selected time period; charging an amount of money for the display of the information on the selected electronic billboard." However, Adler teaches a system which includes a time allocation controller that allocates time available in a particular advertising region in a display device of a function of one of a desired user frequency, a desired time frequency, or a desired geometry, that delivers the advertisements to remote computer for display in the advertising region according to the allocating of the time (abstract).

Adler et al review that typically, the region provided by an Internet advertising provider is not a simple, static billboard. Current Internet technology makes possible continuous, dynamic updates to the contents of advertising regions. An important motivation for this is that providers with a high volume of users may charge higher prices for advertising region, and parcel the space between different advertisements thereby making the advertising region accessible to a larger number of advertisers. Such parceling can be accomplished by selling an advertising region that is smaller than the total area available, by displaying different advertisements to different users, by

dynamically changing the advertisements seen by a given user, or by some combination of two or more of the same (column 1, lines 40-54).

Since Adler teaches remote computers 105a to 105n include public networks of computers via the Internet 115 (figure 1, col. 3, lines 55-57). Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize charging an amount of money for the display of the information on the selected electronic billboard reviewed by Adler on Royal's selected electronic billboard system because client would visit web site at any computers that having Internet to advertise their advertisements via Internet interface on the billboard.

As to claims 19, 20 and 22, Royal teaches a system for displaying information 10 having a plurality of displays advertising 38 (an electronic billboard as claimed) that are located on a list A, B, C and D of the map (see figure 7a); each fuel dispenser 12 having an input device or keypad 40, a card reader 41 (an information handling system as claimed) coupling via accessing a homepage for logging onto the site's asset management system 300 (see col. 8, lines 35-37). The system may control the advertising remotely from the advertising commercials (318) posting interface page 308, which leads to advertising or commercials (318) and provide a way to change advertising and also upload information and advertising at the convenience store or other area in the fueling environment, respectively (see figure 7B, col. 8, lines 50-59). Accordingly, a display 38 at location A corresponds to a first electronic billboard; a display 38 at location B corresponds to a second electronic billboard. Each fuel dispenser 12 having an input device or keypad 40, a card reader 41 correspond to a

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first and a second an information handling system as claimed. The operation display 52 and input 54 (figure 2) corresponding to the claimed a third information handling system as claimed. Royal teaches the user at the browser 25, 27 that will select a device from the list of possible devices on the site network, such as a fuel dispenser, and will connect to the HTTP server on the target device (col. 7, lines 34-37) including a map of North America (see figure 7a). Royal fails to teach "selecting, via the third information handling system, a time period for displaying the information on the selected electronic billboard; and display the information on the selected electronic billboard during the selected time period." However, Adler teaches a system which includes a time allocation controller that allocates time available in a particular advertising region in a display device of a function of one of a desired user frequency, a desired time frequency, or a desired geometry, that delivers the advertisements to remote computer for display in the advertising region according to the allocating of the time (abstract). Since Adler teaches remote computers 105a to 105n include public networks of computers via the Internet 115 (figure 1, col. 3, lines 55-57). Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the third information handling system (105a) selecting a time period (110) for displaying advertised information (205) taught by Adler on Royal's selected electronic billboard system because client would visit web site at any computers that having Internet to advertise the advertisements via Internet interface.

As to claim 21, Royal teaches the user at the Brower 25, 27 that will select a device from the list of possible devices on the site network, such as a fuel dispenser, and will connect to the HTTP server on the target device 108 (see col. 7, lines 34-37).

As to claims 24 and 25, Royal teaches a method of advertising comprising the steps of the user at the browser 25, 27 selecting a device from the list of possible devices on the site network, such as fuel dispenser, and will connect to the HTTP server on the target device 108 (see figure 5, column 7, lines 34-37);

uploading the advertising interface comprising commercial 1 "coke.mpeg", commercial 2 "Frito.mpeg" and commercial 3 "Valvoline.mpeg." at the upload interface (314) of the location store C (see figure 7B);

a consumer gas pump would view the following displays commercial 1 "coke.mpeg", commercial 2 "Frito.mpeg" and commercial 3 "Valvoline.mpeg." where the gas pump had been selected while waiting during pump gas.

Royal fails to teach "display on the selected billboard the advertising information at a selected time." However, Adler teaches a system which includes a time allocation controller that allocates time available in a particular advertising region in a display device of a function of one of a desired user frequency, a desired time frequency, or a desired geometry, that delivers the advertisements to remote computer for display in the advertising region according to the allocating of the time (abstract). Since Adler teaches remote computers 105a to 105n include public networks of computers via the Internet 115 (figure 1, col. 3, lines 55-57). Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the third information handling

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system (105a) selecting a time period (110) for displaying advertised information (205) taught by Adler on Royal's selected electronic billboard system because client would visit web site at any computers that having Internet to advertise the advertisements via Internet interface.

As to claims 27-35, Royal teaches a computer program product (see figure 4, column 5, line 57) having the operation display 52 and input 54 (figure 2) corresponding to the claimed receiving a first network first information via the internet 30; displaying information 10 having a plurality of displays advertising 38 that are located at A of the map corresponding to the claimed sending the first information over a second network to the first designated target display (see figure 7a) via the internet 30.

As to claims 37-41, Royal teaches inherently a computer program product for uploading the advertising or commercials 318 (content as claimed) from the operation display 52 and input 54 (figure 2) via the internet 30; displaying information 10 having a plurality of displays advertising device 38 that are located at A of the map corresponding to the claimed receiving a designation of a target display device to display the content (see figure 7a) via the internet 30. Royal fails to teach "receiving a designation of a time that a target display device is to display the content." However, Adler teaches a system which includes a time allocation controller that allocates time available in a particular advertising region in a display device of a function of one of a desired user frequency, a desired time frequency, or a desired geometry, that delivers the advertisements to remote computer for display in the advertising region according to the allocating of the time (abstract). Since Adler teaches remote computers 105a to 105n include public

networks of computers via the Internet 115 (figure 1, col. 3, lines 55-57). Therefore, It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the third information handling system (105a) selecting a time period (110) for displaying advertised information (205) taught by Adler on Royal's selected electronic billboard system because client would visit web site at any computers that having Internet to advertise the advertisements via Internet interface.

Response to Arguments

5. Applicant's arguments filed 3/3/2003 have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, It would have been obvious to a person of ordinary skill in the art at the time of the invention to utilize the third information handling system (105a) selecting a time period (110) for displaying advertised information (205) taught by Adler on Royal's selected electronic billboard system because client would visit web site at any computers that having Internet to advertise the advertisements via Internet interface.

In response to applicant's argument that claim 14 recites "the steps of selecting, via the third information handling system, a time period for display the information on the selected electronic billboard, and displaying the information on the selected electronic billboard during the selected time period." This argument is not persuasive because Adler's invention teaches "the third information handling system (105a) selecting a time period (110) for displaying advertised information (205) (figures 1 and 2)." These arguments are not persuasive because it is possible for Adler's remote computer 105a to select a time period (110) for displaying advertised information (205) on Royal's electronic billboard that has been selected from at least two separate electronic billboards of Royal, for then displaying that advertised information at that selected time period.

In response to applicant's argument that claims 17 and 55 recite "the map of the first and second locations included within the list of electronic billboards." This argument is not persuasive because Royal's invention teaches "the user selects device from list of possible devices on site network (i.e. device #3) (108) (see figure 5, column 8, lines 16-19) which includes in a map of North America (see figure 7a).

In response to applicant's argument that claims 20-23 recite at page 10, lines 1-5. This argument is not persuasive because the examiner finds a prior art element performs the function specified in the claims, see MPEP 2183.

In response to applicant's argument that claim 24 recite "uploading advertising data to an ebillboard.net server via a remote computer by an advertiser (page 10, line 19-20)." This argument is not persuasive because Royal's invention teaches "the user

starts browser application and connects to home page at site's Uniform Resource Locator URL address (100) via a remote manageable device (106) (see figure 5, column 8, lines 2-12)." These arguments are not persuasive because ebillboard.net server should not disclose in the specification and claim 24 see the rejection above. Moreover, Examiner has check the website address ebillboard.net in the Internet at 5/6/2003, this website address ebillboard.net had been removed by the Applicant.

In response to applicant's argument that claim 24 recite "uploading additional information concerning the advertiser via the remote computer by the advertiser at the advertiser's option." This argument is not persuasive because Royal's invention teaches upload interface (314) at location store C uploads the advertising interface comprising commercial 1 "coke.mpeg", commercial 2 "Frito.mpeg" and commercial 3 "Valvoline.mpeg." (see figure 7B). These arguments are not persuasive because commercial 1, commercial 2 and commercial 3 reply uploading additional information concerning the advertiser as claim 24.

In response to applicant's argument that claim 25 recite "a consumer viewing the selected billboard is informed of the availability of additional information concerning the advertiser at the web site dedicated to the selected billboard (page 10, line 1)." This argument are not persuasive because Royal's invention teaches a consumer gas pump would view the following displays commercial 1 "coke.mpeg", commercial 2 "Frito.mpeg" and commercial 3 "Valvoline.mpeg." where the gas pump had been selected while waiting during pumping gas.

In response to applicant's argument that claim 27 is similarly as given above with respect to claim 14.

In response to applicant's argument that claim 37 is similarly as given above with respect to claim 14.

In response to applicant's argument that claim 40 recite "the steps of outputting information on whether the target display device is available to display the content, permitting a selection of the target display device if it is available to display the content; and preventing a selection of the target display device if it is not available to display the content." This argument is not persuasive because Adler's invention teaches "the second receiving program step of outputting the advertisements (205) comprising on whether the target display device if T time slots are available to display the content (column 9, line 40-43). Each advertisement arrives, a decision must be made as to whether or not to include that advertisement in the schedule (see column 10, line 2).

In response to applicant's argument that claim 41 recite "outputting information on date and time availability of the target display device to display the content; permitting a selection of the target display device at a selected data and time...; preventing a selection of the target display device at the selected data and time..." This argument is not persuasive because Adler's invention teach "the second receiving program step of outputting the advertisements (205) on schedule comprising on whether the target display device if T time slots are available to display the content (column 9, line 40-43). Each advertisement arrives, a decision must be made as to whether or not to include that advertisement in the schedule (see column 10, line 2).

For these reasons, the rejections based on Royal in view of Adler have been maintained.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Kevin M. Nguyen** whose telephone number is **703-305-6209**. The examiner can normally be reached on MON-THU from 9:00-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Richard A Hjerpe** can be reached on **703-305-4709**.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231


or faxed to:

(703) 872-9314 (for Technology Center 2600 only)

Hand-delivered response should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Kevin M. Nguyen
Examiner
Art Unit 2674



RICHARD HJERPE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600